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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,580	02/05/2004	Brian Dean Maxson	705397.4014	6723
34313	7590	10/19/2004		EXAMINER
		ORRICK, HERRINGTON & SUTCLIFFE, LLP		YANG, CLARA I
		4 PARK PLAZA	ART UNIT	PAPER NUMBER
		SUITE 1600		
		IRVINE, CA 92614-2558	2635	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

K.D.

Office Action Summary	Application No.	Applicant(s)
	10/773,580	MAXSON ET AL.
	Examiner	Art Unit
	Clara Yang	2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 February 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-30 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 05 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The expression "now Patent No. 6,714,137" should follow the filing date of the parent application in Section [001].

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 - 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 3, 5 - 14, 17, and 18 of U.S. Patent No.

6,714,137. Although the conflicting claims are not identical, they are not patentably distinct from each other as shown below:

Application No. 10/773580	U.S. Patent No. 6,714,137		
Claim	Col.	Lines	Comments
1	11	11-29	Claim 1 of the application is broader than that of the patent, which requires the primary signal to include a first message, a second message, and a predetermined quiescent period between the messages. Though the patent is silent on interpreting the primary signal during a quiescent period, the patent teaches that the quiescent period is at least equal to the sum of the period of silence needed for the A/V device (i.e., a second receiving device) to detect the third message contained in the secondary signal plus the period of silence needed for the interpreting device to detect either the first or second message contained in the primary signal. In addition, the secondary signal is transmitted during the quiescent period. Consequently, the interpretation of the received primary signal must occur during the quiescent period.
2	11	32-33	
3	11	32-33	
4	11	30-33	Col. 11, lines 32 – 33 require that the first and second message comprise one or more data blocks. Because the patentee claims in Col. 11, lines 30 – 31 that the first message and second message of the primary signal are identical, the data block of the second message is a confirmation of the first message's data block.
5	11	36-37	
6	11	38-39	
7	11	40-41	
8	11 12	26 14-15	Col. 11, line 26 teaches that the second receiving device is an audio/video device, and Col. 12, lines 14-15 teach that the interpreting device is a television.
9	11	13-15	
10	11	14-15	
11	11 11 12	47-48 63-67 1-2	

Application No. 10/773580	U.S. Patent No. 6,714,137		
Claim	Col.	Lines	Comments
12 - 14	12	3-10	Lines 5 – 7 teach the limitations of claim 12. Lines 5 – 10 teach the limitation of claim 13. Lines 3-7 teach the limitation of claim 14.
15	12	11-13	
16	12	16-18	
17	11	40-41	
18	12	14-15	
19	12	21-22	
20	12	23-27	

Claim Objections

4. Claims 10 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Because the quiescent period, as defined in claims 1 and 11, is the sum of the period of silence needed for the interpreting device to detect the first message and the period of silence needed for the second receiving device (such as an audio/video device) to detect the second message transmitted by the interpreting device, the quiescent period is clearly predetermined.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 21 – 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The second limitation in claim 21 (i.e., “superimpose a second message in a predetermined quiescent period following transmission of the first message”) is confusing because it is unclear if the quiescent period begins after the transmission of the first message via a remote control device and continues while the interpreting device’s processing circuitry interprets the first message, transmits the first message to the interpreting device, and generates and transmits a second message to the interpreting device (assuming that the first message contains a delay-sensitive operation command) or if the quiescent period occurs after the processing circuitry of the interpreting device forwards/transmits the first message to the interpreting device for execution. The Examiner interprets the quiescent period to begin after the remote control transmits the first message and continues through the functions of the processing circuitry.

Allowable Subject Matter

7. Claims 21 - 30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or suggest an interpreting device comprising: (a) a receiver for receiving a wireless primary signal; and (b) processing circuitry for determining if the received primary signal contains a first message that commands the interpreting device to execute a delay-sensitive operation, for forwarding/transmitting the first message to the interpreting device, and for superimposing a second message in a predetermined quiescent period following transmission of the first message to the interpreting device if the first message

commands the interpreting device to execute a delay-sensitive operation, wherein the quiescent period the second message commands the interpreting device to execute the same delay-sensitive operation as specified in the first message. It is understood that the quiescent period begins after the transmission of the first message via a remote control device and continues while the interpreting device's processing circuitry interprets the first message, transmits the first message to the interpreting device, and generates and transmits a second message to the interpreting device (assuming that the first message contains a delay-sensitive operation command).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references were cited in the prior U.S. application No. 09/535,263, now U.S. Patent No. 6,7141,37:

- ◆ U.S. Patent No. 5,115,236 (Köhler)
- ◆ U.S. Patent No. 5,455,570 (Cook et al.)
- ◆ U.S. Patent No. 5,525,976 (Balgard)
- ◆ U.S. Patent No. 5,740,542 (Leeper et al.)
- ◆ U.S. Patent No. 5,815,086 (Ivie et al.)
- ◆ U.S. Patent No. 5,870,381 (Kawasaki et al.)
- ◆ U.S. Patent No. 6,160,491 (Kitao et al.)
- ◆ U.S. Patent No. 6,243,022 (Furukawa)
- ◆ U.S. Patent No. 6,496,927 (McGrane et al.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY



BRIAN ZIMMERMAN
PRIMARY EXAMINER